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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,948	04/15/2004	Ralph E. Wesinger JR.	NES-014COR	8227

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EXAMINER	
MAHMOUDI, HASSAN	
ART UNIT	PAPER NUMBER
2165	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/26/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/825,948	WESINGER ET AL.	
	Examiner	Art Unit	
	Tony Mahmoudi	2165	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Office Action for Details*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. The instant application claims benefit of the filing date to the U.S. Application 10/703/823, filed on 07-November-2003, which is a continuation of U.S. Application 09/952,985, filed on 14-September-2001, which is a continuation of U.S. Application 09/110,708, filed on 07-July-1998, which is a continuation of U.S. Application 08/572,543, filed on 14-December-1995. Accordingly, the filing date of the U.S. Application 08/572,543 (14-December-1995) is considered the effective filing date for the examination of the instant application.

Information Disclosure Statements

2. The following IDS submissions have been considered by the Examiner in this Office Action (copies attached):

IDS Submission Date	# of pages
06-November-2006	5
25-October-2006	5
25-October-2006	4
09-February-2006	1
18-August-2005	1
17-June-2005	9
23-March-2005	3 (2 pages each)
05-March-2005	1

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

   Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Independent claims 22, 28, and 34 of the instant application are ***provisionally*** rejected under the judicially created doctrine of double patenting over claims 1, 8, and 15 of copending Application No. 11/381,075 (Wesinger, JR. et al., U.S. Publication No. 2006/0195469 A1.)

Claims 1, 8, and 15 of Patent Application No. 11/381,075 (Wesinger, JR. et al., U.S. Publication No. 2006/0195469 A1) contains every element of claims 22, 28, and 34 of the instant application and as such anticipates claims 1, 9, and 17 of the instant application.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 25-27, 31-33, and 37-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The above identified claims each recite a functional limitation following the term "***allow***" or "***allowing***", which represent system ability/capability, rather than required functionality of the claim. The Examiner cannot clearly establish whether the function following the term "***allow***" or "***allowing***" is indeed a required function of the claimed invention. To overcome this rejection, the above claims must be amended to recite the functions in a definitive forms, by removing the terms "***allow***" or "***act of allowing***" (e.g., "further comprising said user to index said selected entry ....", in claim 25.) Appropriate corrections are required.

Claims 25-27 recite "the act of allowing" in line 1.

Claims 25, 31, and 37 recite, "said selected entry" in line 2.

There is insufficient antecedent basis for these limitations in the above claims. Appropriate corrections are required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Independent claims 22, 28, and 34 (and their dependent claims, where applicable) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The above independent claims produce results that are not considered "tangible". "Associating" entries with categories are not tangible because there is no indication that the "associations" are either stored in memory, communicated to a user (displayed), or outputted on a tangible medium (e.g., printed.)

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 22-24, 28-30, and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Cooper et al (U.S. Patent No. 5,465,167, hereinafter referred to as **Cooper**.)

As to claims 22 and 28, **Cooper** teaches a method for creating entries (see column 13, line 66 through column 14, line 1) in an on-line database (see column 6, lines 51-60, where "on-line database" is read on "data storage medium" on the "network") including a user-defined category and an associated description comprising (see column 8, line 61 through column 9, line 9):

receiving a request from a user to create an entry in an online database (see column 9, lines 14-24, and see column13, line 66 through column 14, line 1);

creating an entry in an on-line database (see column 14, lines 30-36);

receiving a category defined by said user for said entry and a description of said category (see column 11, lines 37-42, and see column 16, lines 50-58); and

associating said entry with said category (see column 11, lines 43-56, and see column 12, lines 12-24.)

As to claims 23, 29, and 35, **Cooper** teaches wherein said entry includes non-textual content (see column 18, line 4 through column 19, line 3.)

As to claims 24, 30, and 36, **Cooper** teaches wherein said non-textual content comprise graphics (see column 19, lines 4-17.)

As to claim 34, **Cooper** teaches a web server for creating entries in an on-line database including a user-defined category and an associated description comprising:

a web server and an associated database, the web server including a HTML front-ending process configured to:

receive a request from a user to create an entry in an online database (see column 9, lines 14-24, and see column13, line 66 through column 14, line 1);

create an entry in an on-line database (see column 14, lines 30-36);

receive a category defined by said user for said entry and a description of said category (see column 11, lines 37-42, and see column 16, lines 50-58); and

associate said entry with said category (see column 11, lines 43-56, and see column 12, lines 12-24.)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that said subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 25-27, 31-33, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cooper** in view of Bernstein et al (U.S. Patent No. 5,297,249, hereinafter referred to as **Bernstein**.)

As to claims 25, 31, and 37, **Cooper** does not teach further comprising an act of allowing said user to index said selected entry in said on-line database with at least one user-defined keyword (although "***an act of allowing*** a user to index" does not carry patentable weight. See sections 5 and 6 of this Office Action for the rejection under 35 U.S.C. 112, second paragraph.)

However, **Bernstein** teaches a hypermedia link master abstract and search service (see Abstract), in which he teaches an act of allowing said user to index said selected entry in said on-line database with at least one user-defined keyword (see column 10, lines 27-51, and see column 21, line 55 through column 22, line 2.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified **Cooper** by the teaching of **Bernstein**, because an act of allowing said user to index said selected entry in said on-line database with at least one user-defined keyword, would result in faster and more accurate searches by the user, in obtaining relevant content that have some common keywords or identifiers.

As to claims 26, 32, and 38, **Cooper** does not teach further comprising an act of allowing said user to add a URL to said entry in said on-line database (although "***an act of allowing*** a user to add a URL to a database entry" does not carry patentable weight. See sections 5 and 6 of this Office Action for the rejection under 35 U.S.C. 112, second paragraph.)

Nonetheless, **Bernstein** teaches hypermedia linking throughout his invention (see, for example, column 21, line 55 through column 22, line 2. Also, see claim 9.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified **Cooper** by the teaching of **Bernstein**, because an act of allowing said user to add a URL to said entry in said on-line database, would allow the user to click a hypermedia link in a database and access the hypermedia content pointed to by that link (see **Bernstein**, column 2, lines 14-62, and see claim 9.)

As to claims 27, 33, and 39, **Cooper** does not teach further comprising an act of allowing said user to add a hyperlink to said entry in said on-line database (although "***an act of allowing*** a user to add a hyperlink to a database entry" does not carry patentable weight. See sections 5 and 6 of this Office Action for the rejection under 35 U.S.C. 112, second paragraph.)

Nonetheless, **Bernstein** teaches hypermedia linking throughout his invention (see, for example, column 21, line 55 through column 22, line 2. Also, see claim 9.)

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified **Cooper** by the teaching of **Bernstein**, because an act of allowing said user to add a hyperlink to said entry in said on-line database, would allow the user to click a hypermedia link in a database and access the hypermedia content pointed to by that link (see **Bernstein**, column 2, lines 14-62, and see claim 9.)

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of art with respect to methods and systems of creating entries in On-line databases in general:

Patent/Pub. No.	Issued to	Cited for teaching
US 6,094,649	Bowen et al.	Keyword searches in structured databases.
US 6,567,812 B1	Garrecht et al.	Query results management in hierarchical data structures.

14. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Tony Mahmoudi whose telephone number is (571) 272-4078. The examiner can normally be reached on Mondays-Fridays from 08:00 am to 04:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached at (571) 272-4146.

December 11, 2006

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